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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/458,132 | 02/16/2000 | WILLIAM R. SPRAGUE | SPRAGUE-REI- | 8479 |

7590 06/06/2002

LAW OFFICES OF ROYAL W. CRAIG
10 NORTH CALVERT STREET
SUITE 153
BALTIMORE, MD 21202

EXAMINER

GEHMAN, BRYON P

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3629

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/458,132

Applicant(s)

SPRAGUE ET AL.

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002 and 07 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 16 and 17 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 3, 2002 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Specification

The amendment filed November 13, 1997 during original prosecution is objected to under 35 U.S.C. 132 because, contrary to applicants' notarized statement made at the time, it introduced new matter into the original disclosure filed August 9, 1996. This is seen to constitute an error in the original patent. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which was not supported by the original disclosure is as follows: At column 2, line 17 of the specification, that the telephone rate information was to be provided in a list form. At column 2, line 18, that the instructions pertained specifically for use. At column 3, lines 49-52, that the printing can comprise a company logo. At column 4, lines 12-16, that the VMP was ever to be manufactured in the configuration of Figure 4 without the bottom perforated portion first existing. The original disclosure describes the arrangement as arrived as a transition from the structure of Figure 3 modified by separation of portions to arrive at the structure of Figure 4. This last is most critical, as the original disclosure never disclosed that Figure 4 was to be made as a starting point,

but rather arrived at after the removal of bottom side 25 from the original packaging 10 in use.

Applicant is required to cancel the new matter in the reply to this Office action.

Response to Arguments

Applicant's arguments filed January 3, 2002 have been fully considered and found persuasive as to the construction of Figures 4-5 comprising a stand alone embodiment, but only commensurate with the original disclosure filed August 9, 1996. In that the specification is not in line with the arrangement of Figures 4-5 as supported by the original disclosure, it is still objected to. Furthermore, a consideration of the substitute specification filed November 13, 1997 indicates that, contrary to applicants' sworn statement at that time, the substitute specification did contain recitation new to the original disclosure. Proper objections in view of these have been made.

Patent owners make the argument that the subject matter the examiner has characterized as new matter was inherent from the original disclosure. While the patent owners make the argument the additions to the specification were obvious, it is not seen that there is any support for the features found in the original disclosure, and the objections are maintained. Patent owners refer to Schering Corp. v. Amgen Inc. as an analogous case. However, it appears in that case that a mere change in nomenclature was made, while the differences in the present application between the original disclosure and the added matter were more than a change in terminology, but a change

in the substance and structure of the invention as supported by the application as filed August 9, 1996. There is no original description of Figure 4 being arrived at other than via the arrangement of Figure 3.

Conclusion

This application is in condition for allowance except for the following formal matters:

The objections with respect to new matter made above.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Bryon Gehman at telephone number (703) 308-3866. My work schedule is normally Tuesday through Friday from 6:30 am through 4 pm.

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Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687 and (703) 305-3597. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

| | |
|---------------------------------|----------------------|
| Allowed Files & Publication | (703) 305-8322 |
| Assignment Branch | (703) 308-9287 |
| Certificates of Correction | (703) 305-8309 |
| Drawing Corrections/Draftsman | (703) 305-8404/ 8335 |
| Fee Questions | (703) 305-5125 |
| Intellectual Property Questions | (703) 305-8217 |
| Petitions/Special Programs | (703) 305-9282 |
| Terminal Disclaimers | (703) 305-8408 |
| Information Help Line | 1-800-786-9199 |

BPG
June 4, 2002



Bryon P. Gehman
Primary Examiner